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Serial No.: 09/394,918  
Group Art Unit: 3724  
Examiner: O. Flores-Sanchez

### REMARKS

Applicants thank the Examiner for permitting a personal interview with Applicants' representative on January 29, 2002. Applicants respectfully request the Examiner to withhold the filing a reply to the present Amendment and Response, until the personal interview with Applicants' representative has taken place.

Claim 9 has been amended to correct an obvious error. Claim 8 was canceled in the Amendment and Response filed August 9, 2001, and claim 9, prior to the amendment, depended from the canceled claim. Claim 9 has been amended to depend from claim 7.

### CLAIM REJECTIONS

#### Claim Rejections under 35 U.S.C. § 102

Claims 7 and 9-12 are rejected under 35 U.S.C. § 102(a). 35 U.S.C. § 102(a) recites that: "A person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent".

The publication date of the reference to Shimizu et al. is April 24, 2001.

The Examiner will note that the U.S. filing date for the Applicants is September 13, 1999. Hence, absent any evidence to the contrary, it is most respectfully believed that the reference to Shimizu et al. cannot be used on the basis of 35 U.S.C. § 102(a). Withdrawal of the rejection is most respectfully requested.

#### Claim Rejections under 35 U.S.C. § 103

Claim 12 is rejected under 35 U.S.C. § 103 as being unpatentable over Shimizu et al. in view of U.S. 6,047,470 (Drussel et al.). As indicated above, it is most respectfully believed that the reference to Shimizu et al. cannot be used on the basis

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of 35 U.S.C. § 102(a), and therefore it would be improper to modify the reference to Shimizu et al. if the rationale for the unobviousness rejection is based on the basis that the rejection under 35 U.S.C. § 102(a) is proper.

Regardless, even if one were to modify the reference to Shimizu et al. according to the teachings of Drussel et al., it is most respectfully believed that the elements of claim 12 cannot be met. The Examiner seeks to modify the reference to Shimizu et al. according to the teachings of Drussel et al.

It is most respectfully believed that the Examiner's understanding of the reference to Shimizu et al. (in regard to the rejection based on 35 U.S.C. § 102(a)) cannot be maintained, since the Examiner stated that Shimizu et al. discloses the process including a strip 100 having a plurality of substrate areas, providing a plurality of alignment marks 18a (Fig. 3A), providing a plurality of cutting marks 2 (Fig. 3A), positioning the saw machine with respect to the substrate area, cutting each individual substrate areas (Fig. 1A). However, in the reference to Shimizu et al., reference character 100 refers to the main board, reference numeral 18a refers to the signs, and reference numeral 2 refers to the cut lines. Although the main board 100 is provided with a plurality of circuit boards, the main board 100 shown in the drawings of Shimizu et al. is not a substrate strip which has a plurality of substrate areas along a longitudinal line as shown in the drawings of the application. Further, the cut lines 2 of Shimizu et al. are determined by a plurality of rectangular signs or pairs 18, wherein the cut line 2 extends between the pairs 18 (as shown in Fig. 1(A)), and the two rectangular pairs 18 determine the position to each cut line 2 in cooperation (column 13, lines 19-22) that are different from the cutting marks of the claimed invention. In contrast, in the claimed invention, the cutting marks 112 are used to define the cutting tracks 101 in relation to the longitudinal axis of the substrate strip 100.

As previously stated in the response filed on August 9, 2001, one of the primary features of the claimed invention is to re-position the saw machine with respect to an adjacent one of the substrate areas for cutting the substrate strip, thereby eliminating the accumulation of the cutting error. This particular feature of the claimed invention

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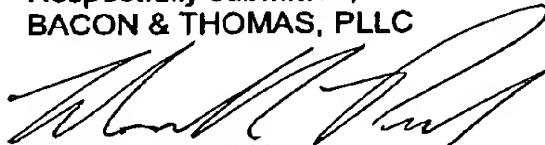
Examiner: O. Flores-Sanchez

is not taught, disclosed or suggested in the reference to Shimizu et al. and/or Drussel et al. Hence, further modification of the reference to Shimizu et al. according to the teachings of Drussel et al., will not result in the claimed invention, in particular regard to claim 12. Hence, withdrawal of the rejection is most respectfully requested.

Withdrawal of the rejection is respectfully requested in view of the remarks above.

In summary, it is respectfully submitted that none of the prior art individually or collectively shows a process for sawing a substrate strip as claimed. Accordingly, withdrawal of the rejection of the claims appears to be warranted and the same is respectfully requested. In the event there are any outstanding matters remaining in the present application which can be resolved by a telephone call or facsimile communication to Applicants' Attorney, the Examiner is invited to contact the undersigned by telephone or facsimile at the numbers provided below.

Respectfully submitted,  
BACON & THOMAS, PLLC



WONKI K. PARK  
Associate Attorney for Applicants  
Registration No. 38,991

Date: January 25, 2002

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625 Slaters Lane, Fourth Floor  
Alexandria, Virginia 22314  
Telephone: 703-683-0500  
Facsimile: 703-683-1080

WKP/jfm

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**APPENDIX OF MARKED-UP AMENDED CLAIM**

9. (Twice Amended) The process as claimed in Claim [8] 7, further comprising the step of cutting the substrate strip according to cutting tracks defined by the cutting marks parallel to the longitudinal axis.

|                          |                     |              |  |
|--------------------------|---------------------|--------------|--|
| <b>Interview Summary</b> | Application No.     | Applicant(s) |  |
|                          | 09/394,918          | SU, JAU-YUEN |  |
|                          | Examiner            | Art Unit     |  |
|                          | Omar Flores-Sánchez | 3724         |  |

All participants (applicant, applicant's representative, PTO personnel):

(1) Omar Flores-Sánchez.

(3) Kenneth Peterson.

(2) Wonki K. Park.

(4) \_\_\_\_\_

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Date of Interview: 29 January 2002.

Type: a) ☐ Telephonic b) ☐ Video Conference  
c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 7 and 9-12.

Identification of prior art discussed: \_\_\_\_\_.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Discussed the language that appear to distinguish over Shimizu et al. under 102. Where in the cut lines of claims distinguish over shimizu.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☐ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

  
Examiner's signature, if required

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\*\*\* TX REPORT \*\*\*  
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J. ERNEST KENNEY  
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## FACSIMILE COMMUNICATION

To: Mr. Omar Flores-Sanchez  
Group Art Unit: 3724

Fax #: (703) 305-3579  
(703) 872-9302

Re: U.S. Patent Application No. 09/394,918  
Inventor: J. SU

From: Wonki K. Park  
Associate Attorney

Total pages: 2 including the cover sheet

Date: February 6, 2002

### Confidential/Privileged

This communication contains confidential information that is intended to be received and read only by the party named as addressee (listed after "To:" at the left). This communication may contain information that is subject to the attorney/client privilege and/or a court order restricting its dissemination. No one else is entitled to read, use, copy or disseminate this communication or the information contained herein. If you are not the addressee, or the agent of the addressee, then contact us immediately by telephone (collect) or facsimile and arrangements will be made for the return to us of this communication.

Thank you, BACON & THOMAS, PLLC.

### Message:

Thank you for the courteous interview held on January 29, 2002. During the interview we discussed claim 7, and in particular we discussed page 3, second full paragraph of my amendment and response filed on January 25, 2002.

As is noted in the interview summary, you indicated that if claim 7 is amended to add language that distinguishes over the reference to Shimizu et al., the application will be reviewed favorably. We also agreed in the interview that the use of the reference to Shimizu et al. under 35 U.S.C. 102 (a) is improper.

Please review the attached proposed new claim 13 (DRAFT) which will replace claim 7. Claims 9-12 will be amended to depend from claim 13 if claim 13 is deemed allowable. Please promptly let me know if you believe further amendments are necessary. Claim 13 recites language which illustrates the inventive subject matter that clearly distinguishes over the Shimizu et al. reference.

J. ERNEST KENNEY  
EUGENE MAX  
RICHARD E. FICHTER  
THOMAS J. MOORE  
JOSEPH DEBENEDICTIS\*  
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## FACSIMILE COMMUNICATION

**To:** Mr. Omar Flores-Sanchez  
Group Art Unit: 3724

**Fax #:** (703) 305-3579  
(703) 872-9302

**Re:** U.S. Patent Application No. 09/394,918  
Inventor: J. SU

**From:** Wonki K. Park  
Associate Attorney

**Total  
pages:** 2 including the cover sheet

**Date:** February 6, 2002

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Thank you, BACON & THOMAS, PLLC.

### Message:

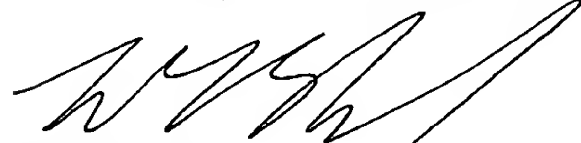
Thank you for the courteous interview held on January 29, 2002. During the interview we discussed claim 7, and in particular we discussed page 3, second full paragraph of my amendment and response filed on January 25, 2002.

As is noted in the interview summary, you indicated that if claim 7 is amended to add language that distinguishes over the reference to Shimizu et al., the application will be reviewed favorably. We also agreed in the interview that the use of the reference to Shimizu et al. under 35 U.S.C. 102 (a) is improper.

Please review the attached proposed new claim 13 (DRAFT) which will replace claim 7. Claims 9-12 will be amended to depend from claim 13 if claim 13 is deemed allowable. Please promptly let me know if you believe further amendments are necessary. Claim 13 recites language which illustrates the inventive subject matter that clearly distinguishes over the Shimizu et al. reference. The bold-type highlights some of the differences between claim 13 and the Shimizu et al. reference.

At your convenience, you can reach me at (703) 683-0500.

Thank you for your kind attention to this matter.



WONKI K. PARK

**DRAFT****COPY****PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Jau-Yuen SU

Group Art Unit: 3724

Serial No.: 09/394,918

Examiner: O. Flores-Sanchez

Filed: September 13, 1999

Atty. Dkt.: SUJA3001/REF/WKP

For: PROCESS FOR SAWING SUBSTRATE STRIP

**PROPOSED NEW CLAIM 13 WHICH WILL BE SUBSTITUTED FOR CLAIM 7  
(FOR DISCUSSION PURPOSED ONLY)**

13. (New) A process for sawing a substrate strip having a plurality of substrate areas by a saw machine, wherein the substrate has a longitudinal axis and a lateral axis and the substrate areas are grouped along the longitudinal axis, the process comprising the steps of:

providing a plurality of alignment marks around each of the individual substrate areas on the substrate strip;

providing a plurality of cutting marks around the substrate areas on the substrate strip such that two opposing longitudinal rows of the cutting marks are provided along the longitudinal axis of the substrate and two opposing lateral rows of the cutting marks are provided along the lateral axis with the substrate areas positioned between the longitudinal and lateral rows of the cutting marks;

positioning the saw machine with respect to a first substrate area according to the alignment marks of the first substrate area along the longitudinal axis and cutting the substrate strip on cutting tracks defined between respective ones of the cutting marks parallel to the lateral axis; and

repositioning the saw machine with respect to an adjacent one of the substrate areas and cutting the substrate strip according to the step of positioning the saw machine, whereby cutting error that results from each substrate area will not accumulate to the adjacent substrate area.



**BACON & THOMAS**

625 Slaters Lane 4th FL, Alexandria, VA 22314

PATENT APPLICATION  
(PENDING)

Serial No: 09/394,918

Filed: September 13, 1999

Attorney: EM/WKP/SU/4973

**COPY****SUJA 3001**

Applicant(s): Jau-Yuen SU

☒ MAILROOM☒ ART UNIT 3724~~PLEASE HAND-CARRY TO:~~**GROUP 3700****Crystal Plaza 2, 2<sup>nd</sup> FLOOR RECEPTION**Special Instructions:

The PTO stamp hereon acknowledges receipt of:

- ☒ **Supplemental Amendment And Statement Of The Substance Of The Interview**
- ☐ Check for \$ ☐ Appeal Brief (Triplicate) ☐
- ☐ Issue Fee ☐ Priority Document
- ☐ Preliminary Amendment ☐ Assignment and Recordation Form
- ☐ Extension of Time Petition ☐ Notice of Appeal ☐ Cover Sheet
- ☐ Terminal Disclaimer ☐ Substitute Declaration
- ☐ Reply Brief (Triplicate) ☐ Information Disclosure Stmtnt. ----☐ with refs.
- ☐ Sheets of Drawings ☐ Request for CPA
- ☐ Sm. Entity Statements -- ☐ Formal ☐ Informal
- ☐ Inv. ☐ Sm. Bus. ☐ Non-Inv. ☐ Non-Profit

Filed By: WKP/jfm

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: JAU-YUEN SU ET AL.

SERIAL NO.: 09/394,918

GROUP ART UNIT: 3724

FILED: September 13, 1999

EXAMINER: O. Flores-Sanchez

FOR: PROCESS FOR SAWING SUBSTRATE STRIP

ATTY. REFERENCE: EM/WKP/SU/4973

THE COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

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Sir:

Transmitted herewith is a SUPPLEMENTAL AMENDMENT AND STATEMENT OF THE SUBSTANCE OF THE INTERVIEW in the above-identified application.

- ☐ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.
- ☒ No additional fee is required.

The fee, if any, has been calculated as shown below:

| Fee Base   | Number of Claims After Amendment | Highest Number of Claims in Prior Art | Extra Claims     | Small Entity |                  |
|--|----------------------------------|---------------------------------------|------------------|--------------|------------------|
| Total Claims   | 6                                | 20 <sup>1</sup>                       | = 0 <sup>3</sup> | × \$ 9 =     | × \$ 18 = \$0.00 |
| Independent Claims   | 2                                | 3 <sup>2</sup>                        | = 0 <sup>3</sup> | × \$ 40 =    | × \$ 80 = \$0.00 |
| <input type="checkbox"/> First Presentation of Proper Multiple Dependent Claim |                                  |                                       |                  | + \$135 =    | + \$270 =        |
| TOTAL  |                                  |                                       |                  |              | \$0.00           |

<sup>1</sup> If less than 20 enter 20.<sup>2</sup> If less than 3 enter 3.<sup>3</sup> If less than 0 enter 0.

- ☐ Please charge my Deposit Account Number 02-0200 in the amount of \$\_\_\_\_\_. A duplicate copy of this sheet is attached.
- ☐ A check in the amount of \$\_\_\_\_\_ is attached.
- ☒ The Commissioner is hereby authorized to charge any additional fees associated with this communication, including fees due under 37 CFR 1.16 and 37 CFR 1.17 or credit any overpayment to Deposit Account Number 02-0200. A duplicate copy of this sheet is attached.
- ☒ Also enclosed is/are:

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23364

PATENT TRADEMARK OFFICE

DATE: February 28, 2002

Respectfully submitted,

WONKI K. PARK

Attorney for Applicant

Registration Number: 38,991